

Serial #: 09/444,889
In reply to Office action mailed March 25, 2004
Page 9 of 12

Remarks/Arguments

1. Introduction

Claims 17-37 are currently pending in the application. Claims 17, 21, 22, 26, 27, and 31 are amended herein and are fully supported by the specification. Claims 32-37 are new and are likewise fully supported by the specification. Applicant has amended the claims to clarify the claim language. Claims 19, 20, 24, 25, 29, and 30 are canceled. No new matter has been added to the prosecution of this application. For at least the reasons stated below, Applicant asserts that all claims are now in condition for allowance.

2. Claim Rejections Under 35 U.S.C. § 112

Claims 17-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has amended claims 17, 22, and 27 to clarify the claimed subject matter, as suggested by the Examiner. Accordingly, Applicant asserts that the 35 U.S.C. § 112, second paragraph rejection is moot, and Applicant requests withdrawal of the rejection.

3. Claim Rejections Under 35 U.S.C. § 103

Claims 17-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekizawa, U.S. Patent No. 6,430,711 B1 (hereinafter "*Sekizawa*") and Haluska, U.S. Patent No. 5,638,519 (hereinafter "*Haluska*"). Applicant opposes this rejection on two grounds: (1) Applicant's conception of the presently claimed invention predates *Sekizawa*; and (2) not all limitations of the claims, as amended, are disclosed or suggested by the cited references.

A. The Prior Art Cited by the Examiner Is not Relevant to the Obviousness Inquiry.

Applicant asserts that *Sekizawa* is inapplicable to the present inquiry because Applicant's invention predates the filing of the *Sekizawa* application. Applicant respectfully requests that the Examiner consider the attached declaration of inventor Michael G. Mikurak. Applicant asserts that the declaration should permit Applicant to swear behind the *Sekizawa* reference, eliminating the prior art on which the Examiner relies in allegedly demonstrating that Applicant's invention is obvious pursuant to 35 U.S.C. § 103(a).

Serial #: 09/444,889
In reply to Office action mailed March 25, 2004
Page 10 of 12

An "[a]pplicant may overcome a 35 U.S.C. [§] 103 rejection based on a combination of references by showing completion of the invention by [the] applicant prior to the effective date of any of the references." MPEP § 715.02, ¶ 4. Antedating a reference is accomplished by producing a declaration of the inventor attesting that the date of invention of the claimed invention is prior to the effective date of the reference claimed as prior art by the Examiner. See 37 C.F.R. § 1.131 (2003).

In the prosecution of the presently claimed invention, the Examiner produced as prior art *Sekizawa*, of which the effective date is January 6, 1999. This filing date is approximately eleven months prior to the filing date of the present applicant (November 22, 1999). Michael G. Mikurak, inventor of the claimed invention, conceived of the claimed invention prior to January 6, 1999. Decl. of Michael G. Mikurak, June 15, 2004. Because the inventor conceived of the claimed invention prior to the effective date of *Sekizawa*, *Sekizawa* is inapplicable and may not be used in combination with *Haluska*, U.S. Patent No. 5,638,519, to argue that Applicant's claimed invention is obvious in light of the prior art. On this basis, Applicant asserts that rejection under 35 U.S.C. § 103 is inappropriate and should be withdrawn, and that the claims should now be allowed.

B. *Sekizawa* in Combination with *Haluska* Fails to Disclose or Suggest All Limitations of Applicant's Independent Claims.

Aside from the fact that *Sekizawa* is no longer relevant, Applicant asserts that *Sekizawa* and *Haluska* do not teach or suggest all elements of the presently claimed invention. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03, ¶ 1. In the present case, the references, either individually or in combination, fail to teach or suggest all limitations of the present invention, as amended.

Specifically, *Sekizawa* fails to disclose or suggest all limitations of Applicant's claims, as amended. *Sekizawa* discloses a method for monitoring printer status on a network, allowing a user to of the invention to review generated status reports of individual network connected entities. See, e.g., Abstract, col. 2, l. 65 – col. 3, l. 59. However, *Sekizawa* fails to disclose or suggest a framework manager, in the course of performing maintenance to the framework managed, that submits feedback requests to the framework users as claimed by Applicant. There is no mention of seeking such feedback because the users of the framework in *Sekizawa* are not entities, such as service providers, vendors, resellers,

Serial #: 09/444,889

In reply to Office action mailed March 25, 2004

Page 11 of 12

manufacturers and the like, that exist separate from the framework such that they may disconnect from the framework and still operate on a stand-alone basis. See Claim 17 preamble; *Sekizawa*, col. 2, l. 65- col. 3, l. 59 (one entity operating with the framework is a printer, which cannot be disconnected and operate independently). Accordingly, it follows that *Sekizawa* fails to disclose seeking feedback from framework users in the course of providing framework maintenance.

The modification of *Sekizawa* with the teachings of *Haluska* fails to disclose or suggest all of the limitations of Applicant's claims, as amended. *Haluska* discloses a method "for automatically controlling and tracking information related to business transactions occurring between a provider and receiver of goods." *Haluska*, Abstract, col. 2, ll. 50-55, col. 5, ll. 40-48. However, there is no disclosure or suggestion of integrating the solicitation or receipt of feedback information from individuals using the network. Accordingly, Applicant asserts that the combination of *Sekizawa* with the teachings of *Haluska* fails to remedy the deficiencies of *Sekizawa*. Thus, the rejection of Independent claims 17, 22, and 27 with the combination of *Sekizawa* and *Haluska* is improper. Applicant requests reconsideration and withdrawal of the rejection.

C. The Remaining Dependent Claims Are Also in Condition for Allowance

Applicant also submits that the rejections of dependent claims 18, 21, 23, 26, 28, 31 through 37 should be withdrawn as they depend on Independent claims 17, 22, and 27. "If an Independent claim is nonobvious under 35 U.S.C. [§] 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03, ¶ 1. Because independent claims 17, 22, and 27 are nonobvious, the claims depending from them are likewise nonobvious. Because the independent claims are in condition for allowance, rejection of such dependent claims is improper, and Applicant respectfully requests the rejections be withdrawn.

Serial #: 09/444,889

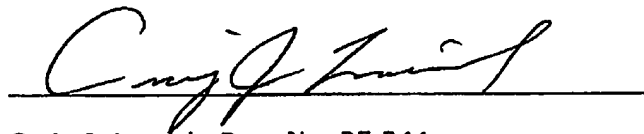
In reply to Office action mailed March 25, 2004

Page 12 of 12

4. Conclusion

Applicant submits that for at least the reasons stated above, all pending claims are allowable over the art of record and respectfully requests reconsideration and that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7387. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-336701).

Respectfully submitted,



Craig J. Lervick, Reg. No. 35,244
Customer No. 29838
OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402
Phone: (612) 607-7387
Fax: (612) 607-7100
E-mail: CLervick@oppenheimer.com
Customer No. 34205

OPPENHEIMER: 2238687 v01 06/28/2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial #: 09/444,889
Applicant: Michael G. Mikurak
Filed: November 22, 1999
Title: SCHEDULING AND PLANNING MAINTENANCE AND SERVICE IN A NETWORK-BASED SUPPLY CHAIN ENVIRONMENT

TC/AU: 3623
Examiner: B. Van Doren
Docket #: 60021-336701

DECLARATION OF MICHAEL G. MIKURAK

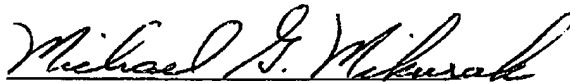
I, MICHAEL G. MIKURAK, hereby declare that:

1. I am the inventor of the invention claimed in U.S. Patent Application Serial No. 09/444,889, originally titled "A System, Method, and Article of Manufacture for Scheduling and Planning Maintenance and Service in a Network-Based Supply Chain Environment", Attorney Docket No. 060021-336701.
2. I was a partner at Accenture (formerly Andersen Consulting) from approximately July 1996 until July 2003, at which point I retired.
3. During my tenure at Accenture, I was part of the Supply Chain Management group, developing solutions for numerous global clients. While providing solution proposals to multiple clients in the telecommunications industry, I realized these maintenance and service processes employed in a network-based supply chain environment could be used across industries, at which point I sought to patent this invention. This conception occurred before January 6, 1999.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: June 15, 2004

Signature:



Michael G. Mikurak
6118 Kipps Colony Drive West
Gulfport, FL 33707
Telephone: (727) 344-6699

CERTIFICATE OF TRANSMISSION

I hereby certify under 37 CFR 1.8 that this correspondence is being transmitted by facsimile to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" via the facsimile number 703-872-9306 on June ~~28~~²⁹, 2004.


Janet Byrne